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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) ULT-001-1P
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Signature <u>Rebecca A. Baumann</u>		First Named Inventor Bert D. Cook, Jr. et al.
Typed or printed name Rebecca A. Baumann		Art Unit 2876 Examiner Daniel I. Walsh
Applicant requests review of the second non-final office action dated October 19, 2005 in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal.		
The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the		 Signature: Patrick T. Bever
<input type="checkbox"/> applicant/inventor.		
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/> attorney or agent of record. Registration number: 33,834		Telephone number: (408) 451-5902
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		Date <u>March 20, 2006</u>
Registration number if acting under 37 CFR 1.34 _____		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.		

*Total of _____ forms are submitted.

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ARGUMENTS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Claims 1-18, 23-40 and 66-74 were finally rejected on September 15, 2004. Applicant appealed the rejection, and submitted an Appeal Brief on May 16, 2005. Examiner Walsh reopened prosecution on September 21, 2005, and issued the currently-pending non-final Office action on October 19, 2005. Presently, Claims 1-40 and 66-76 stand rejected.

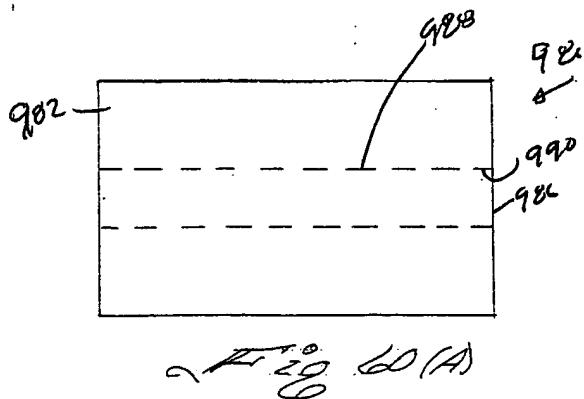
1) Claims 6, 10, 15, 19-22 and 73-76 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 and 6-11 of US Patent No. 6,867,569 (hereinafter "Smith") in view of U.S. Patent No. 5,288,942 (hereinafter "Godfrey").

Applicant respectfully traverses the obviousness-type double patenting rejection as improper. The purpose for rejecting claims under both statutory and non-statutory obviousness-type double patenting is to prevent the unjustified extension of patent exclusivity beyond the term of a patent (MPEP Section 804). In the present case, Claim 1 of Smith is clearly patentably distinguished over Claim 6 of the present application. Claim 1 of Smith is directed to a "data unit", and, in contrast, pending independent Claims 6 and 15 are directed to a "portable card" and Claim 73 is directed to a "magnetically encoded card". Claim 1 of Smith recites a "data card reader" that is not recited in pending Claims 6, 15 and 73. Clearly, the scope of the claimed invention in Smith is entirely different than the scope of the claims in the present application. Applicant respectfully argues that the present rejection is unsupportable at best, and perhaps may be considered frivolous. Reconsideration and withdrawal is therefore requested.

2) Claims 1-2 are rejected as anticipated under 35 U.S.C. 102(b) by Godfrey; Claims 6-18, 23-40 and 66-74 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey; Claim 3 is rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Published Patent Application No. US2001/00052543; Claims 4-5 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 6,184,788

All of these rejections are substantially identical to those addressed in Applicant's Appeal Brief, with the 35 USC 102 rejection of Claims 1 and 2 being merely a restatement of the previous rejection under 35 USC 103 (with minor changes). Therefore, and the arguments raised in the Appeal Brief (and paraphrased below) are considered still valid.

The claimed invention is directed to a credit card-type "portable card" including a card-like "substrate" housing a "storage member" for storing information. An exemplary portable card is disclosed in Applicants' Fig. 60(A) (reproduced below for reference with corresponding text from page 97 of Applicants' specification) :



The embodiment of a portable card 980 illustrated in Figs. 60(A), 60 (B) and 60 (C) has a substrate 982 formed of a predetermined shape, e.g. rectangular, square, circular or the like. The predetermined shape of the preferred embodiment illustrated in Figs. 60(A), 60 (B) and 60 (C) is that of a credit card. (Page 97, lines 9-14.)

Independent Claims 1, 6, 15, 23, and 66 recite that the "portable card" includes a "storage member having at least one layer of storage material for storing information" (Claim 73 is slightly different). Each independent claim also recites that the "storage member" is housed in the "substrate" such that "said storage member and said substrate being adapted to be transported relative to each other to ...

expose at least a portion of said storage member to ...
facilitate processing of stored information".

In contrast to the credit card-type "portable card" recited in independent Claims 1, 6, 15, 23, 66, and 73, Godfrey is clearly directed to a credit card holder that includes a "keeper" held between outer covers that form a pocket for receiving a credit card:

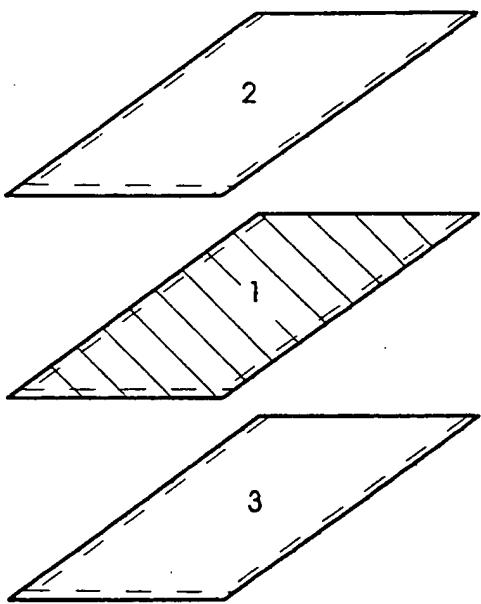


Fig. 2

Godfrey, column 3, lines 4-25

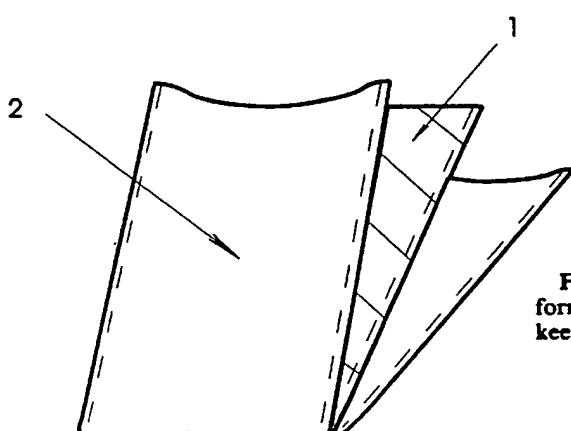
The best mode for carrying out the invention is a cardholder for two credit cards. In FIG. 2, part 1 is the keeper, a first embodiment of said keeper being a composite sheet 0.1 mm thick with a smooth, low friction surface finish. The sheet composition is a fine powder of magnetically soft iron, a polymer such as pvc or polyethylene and a suitable binder, making a material of 10 high resistivity. The soft iron powder content is as high as possible consistent with the requirements of mechanical strength and smooth surface finish of the sheet.

The sheet is homogeneous but an alternative would be a polymer substrate coated on both sides with the 15 ferromagnetic material in a suitable binder. The technology for fabrication of this type of sheet is well known, for example in the manufacture of recording tape and computer floppy discs (which, incidentally, use magnetically hard material).

The outer covers (parts) 2 and 3 are covers made of 0.05 mm thick transparent pvc and may be attached by glueing, welding, stitching or whatever is best suited to the method of manufacture. (Note that known cardholders consist of parts 2 and 3 only).

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Godfrey, column 3, lines 55-57

FIG. 3 shows an embodiment of the invention in the 55 form of a cardholder which can be made using one keeper (1) and a folded cover (2).

Fig. 3

In rejecting Claim 1 under 35 USC 102 over Godfrey, the Examiner repeats the identical argument previously raised in his rejection under 35 USC 103:

Re claim 1, Godfrey teaches a portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member with the substrate (FIG. 3, abstract, and col 1, lines 5+).

Godfrey's Fig. 3 is reproduced above, and Godfrey's abstract and Col 1, lines 5-12 are copied below for reference:

[57] **ABSTRACT**

In the technical field of known cardholders for devices such as cards with magnetic stripes on which is encoded information and or data in the form of patterns of magnetism, the known cardholders offer no method of 'keeping' (in magnetism terminology) the magnetic patterns. The present invention is characterised by incorporating into the cardholders, keepers in the form of sheets of magnetically soft ferromagnetic material with high resistance. The benefit of the invention is obtained when devices are placed with the reading surface of their magnetized stripes in close contact with the surface of the ferromagnetic material which, making use of known properties of the material, then acts as keeper of the magnetic patterns.

Godfrey, column 1, lines 5-12

TECHNICAL FIELD

In the technical field of holders for devices on which information and/or data is encoded in the form of patterns of magnetism, the present invention concerns a method of 'keeping' (in magnetism terminology) the said magnetic patterns. The term 'patterns' includes any arrangement of magnetism such as regular or irregular lines, dots, waves, areas of magnetism, areas of reversed polarity and unmagnetised areas.

Applicant respectfully traverses the Examiner's characterization of Godfrey as teaching a "portable card", and as including a "storage member...for storing information". As underlined by Applicant's attorney in Godfrey's Abstract and Technical Field above, Godfrey's "keeper" is a clearly a sheet of magnetically soft ferromagnetic material with high resistance whose purpose of is not to store information, but to prevent loss of information from, e.g., credit cards that are stored in the credit card holder (see, for example, column 1, lines 25-35,

and column 2, lines 17-24, both reproduced below for reference) :

Godfrey, column 1, lines 25-35

Possibly not so well known is the fact that the magnetic patterns are subject to gradual degradation due to the natural thermal activity and slowing down of the magnetic spin of the molecules of the magnetised material. Such degradation can be reduced by the use of 'keepers' to establish low reluctance paths to enable the magnetic lines of force to complete their natural circuits. To achieve this result a keeper should be in close contact with the face of the device from which lines of magnetism, emanate, i.e. the face from which the encoded information is read.

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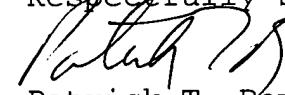
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Godfrey, column 2, lines 17-24

The benefit of the invention is obtained when devices, such as credit cards, are inserted into the card-holders with the reading surfaces of their magnetized components in close contact with the surfaces of the keepers. To avoid physical damage to the magnetized components, the keepers having a smooth, low friction and/or lubricated surface finish.

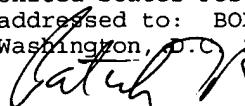
Because Godfrey's "keeper" does not store information, Applicants contend that Godfrey's credit card holder is no more a "portable card" than a purse is a credit card. As such, Godfrey fails to anticipate the "portable card" of Claim 1 because Godfrey fails to teach or suggest the "storage member" recited in Claim 1. Further, it would not have been obvious to replace the Godfrey's keeper with a "storage member" because to do so would defeat the entire purpose of Godfrey's stated invention. For at least these reasons, Godfrey fails to anticipate the subject matter of Claim 1, and it would not have been obvious to modify Godfrey to produce the "portable card" recited in Claim 1. The remaining claims are distinguished over Godfrey and any other cited prior art for similar reasons. Reinstatement of the Appeal process is therefore respectfully requested.

Respectfully submitted,



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Attorney for Appellant

March 20, 2006

Date of Signature